DETAILED ACTION

The Examiner acknowledges the applicant's submission of the amendment dated 11/28/11. At this point, claims 9, 11, and 13 have been amended.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

REJECTIONS NOT BASED ON PRIOR ART

DEFICIENCIES IN THE SPECIFICATION

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. 37 CFR § 1.75 (d)(1) requires that the claim(s) must conform to the invention as set forth in the remainder of the specification and that the terms and phrases used in the claims must find clear support or antecedent basis in the description, so that, the meaning of the terms may be ascertainable by reference to the description.

As amended, claim 9 now reads "wherein, when the host machine does not store the reproduction program data beforehand, the execution program data and the driver program data, the install program data automatically installs the reproduction program data, the execution program data and the driver program data on the host machine in response to connecting the portable memory device to the host machine".

However, the language in the specification reads:

[0009] *If the host machine does not store the reproduction program data and execution program data*, the memory device may store a program for automatically or manually installing the reproduction program data and execution program data in the host machine. In this case, when the terminal of the memory device is connected to the host machine, the install program can be executed to install the reproduction program and execution program. As a result, even an apparatus other than the host machine can reproduce image data and the like stored in the memory device by using the reproduction program and execution program.

[0010] According to an embodiment of the present invention, *if the host machine stores beforehand at least the reproduction program data and execution program data* and when the terminal is connected to the interface in the state that the storage element stores at least one of the image data and audio data, the host machine activates the execution program in response to the detection signal to read and reproduce at least one of the image data and audio data stored in the memory element.

This language indicates that both the execution program data *and* the reproduction program data are not stored beforehand, instead of just the reproduction program data as currently claimed.

Appropriate correction to the claims indicating that the reproduction program data, execution program data, and driver program data are not stored beforehand is required to conform with the specification.

DEFICIENCIES IN THE CLAIMED SUBJECT MATTER

Claim Rejections - 35 USC ' 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention.

As amended, claim 9 now reads "wherein, when the host machine does

not store the reproduction program data <u>beforehand</u>, the execution program data

and the driver program data, the install program data automatically installs the

reproduction program data, the execution program data and the driver program

data on the host machine in response to connecting the portable memory device

to the host machine".

However, the language in the specification reads:

[0009] *If the host machine does not store the reproduction program data and execution program data*, the memory device may store a program for automatically or manually installing the reproduction program data and execution program data in the host machine. In this case, when the terminal of the memory device is connected to the host machine, the install program can be executed to install the reproduction program and execution program. As a result, even an apparatus other than the host machine can reproduce image data and the like stored in the memory device by using the reproduction program and execution program.

[0010] According to an embodiment of the present invention, *if the host machine stores beforehand at least the reproduction program data and execution program data* and when the terminal is connected to the interface in the state that the storage element stores at least one of the image data and audio data, the host machine activates the execution program in response to the detection signal to read and reproduce at least one of the image data and audio data stored inthe memory element.

This language indicates that both the execution program data *and* the

reproduction program data are not stored beforehand, instead of just the

reproduction program data as currently claimed. 37 CFR § 1.75 (d)(1) requires

that the claim(s) must conform to the invention as set forth in the remainder of

the specification and that the terms and phrases used in the claims must find

clear support or antecedent basis in the description, so that, the meaning of the

terms may be ascertainable by reference to the description.

Appropriate correction to the claims indicating that the reproduction

program data, execution program data, and driver program data is not stored

beforehand is required to conform with the specification.   Claims 11 and 13 have

a similar issue.

ARGUMENTS CONCERNING NON-PRIOR ART REJECTIONS/OBJECTIONS

Specification Objections

Applicant's arguments/amendments with respect to the specification have

been considered and have overcome the Examiner's prior objections and thus

are withdrawn.

Rejections - USC 112

Applicant's argument that the amendment to claims 9, 11, and 13 obviates

the rejection under 35 U.S.C. 112 has been considered and is persuasive, but a

new 112 1st rejection has been made as noted in the rejection above.

CLOSING COMMENTS

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the

application as recommended by **M.P.E.P. ' 707.07(i)**:

ALLOWABLE SUBJECT MATTER

Claims 9, 11, and 15 would be allowable if rewritten or amended to

overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this

Office action.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to M. Anthony Giardino whose telephone

number is (571) 270-3565 and can normally be reached on Monday - Thursday

7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272 - 4098.

The fax phone number for the organization where this application or proceeding

is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

M.A. Giardino   /Stephen Elmore/
                                                      Primary Examiner
/M.G./   Art Unit 2188

Patent Examiner
Art Unit 2185

December 4, 2011